



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	Art Unit: 2177
)	
Robert T. BURGER, et al.)	Examiner: G. Robinson
)	
Serial No.: 09/258,123)	
)	
Filed: February 26, 1999)	Atty. Dkt. No.: 107227.00102
)	MCG:DJE:
For: METHOD, STORAGE MEDIUM AND)	
SYSTEM FOR ELECTRONICALLY)	August 22, 2001
VIEWING MULTI-PAGE DOCUMENT)	
WHILE PRESERVING APPEARANCE)	
OF PRINTED PAGES)	

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RESPONSE TO OFFICE ACTION

Commissioner for Patents
Washington, D.C. 20231

Sir:

This Response is filed in response to the Office Action dated February 23, 2001. A Request for a Three-Month Extension of Time is filed concurrently herewith. The Office Action has been carefully considered, and in response thereto, the Applicants respectfully submit that the application as it stands is in condition for allowance. Accordingly, reconsideration and withdrawal of the outstanding grounds of rejection and allowance of claims 1-84 are respectfully solicited.

In the Office Action, the Examiner rejects claims 13-39 and 68-84 under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 5,963,966 to *Mitchell et al* in view of U.S. Patent No. 6,161,107 to *Stern*; rejects claims 1-9, 12, 40-50 and 53-67 under 35 U.S.C. §103(a) as obvious over *Mitchell et al* in view of U.S. Patent No. 4,918,588 to *Barrett et al*; and rejects

claims 10, 11, 51, 52, 64 and 65 under 35 U.S.C. §103(a) over *Mitchell et al* in view of *Barrett et al* and further in view of *Stern*. For the reasons set forth below, the Applicants respectfully traverse all outstanding grounds of rejection.

Claims 13-39 and 68-84 stand rejected under 35 U.S.C. §103(a) over *Mitchell et al* in view of *Stern*. According to those claims, *inter alia*, software to view the viewable files is written on the medium. The passages cited in the Office Action for that teaching do not identify any such software written on the medium. The Unix "grep" command is not software to view the viewable files, but is merely a text-search command. The end of the specification includes a cryptic reference to "disk and CDROM viewers (conventional word processor programs and edit/viewer utilities)," but there is no teaching or suggestion that such programs would be included on the medium. The teaching of persistence in *Stern* does not overcome that deficiency of *Mitchell et al*. Therefore, the Applicants respectfully submit that the combination of references proposed in the Office Action would not have resulted in the present claimed invention.

With regard to the typed name of the heading, as recited in claim 19, the Office Action points to Fig. 5 of *Mitchell et al*. However, that figure shows no such thing.

With regard to Java, the Office Action argues that it would have been obvious to incorporate Java as taught by *Stern* into the teachings of *Mitchell et al* "because the system architecture provides a framework for interaction between different objects over the Internet by using HTTP Web servers and existing web browsers" and because "the technology of the JAVA language enables one to communicate with other applications over the World Wide

Web.” However, the relevant consideration is not whether a modification to the prior art could have been made, but whether the references suggest the desirability of such a modification. *In re Laskowski*, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989). In the present case, *Mitchell et al* teaches that existing Web browsers, word processor programs and edit/viewer utilities are adequate to view the online version of the document, with the result that a person having ordinary skill in the art would not have appreciated the desirability of further incorporating a device-independent language such as Java. As for “interaction between different objects over the Internet” and the ability “to communicate with other applications over the World Wide Web,” the Office Action does not explain why either of those abilities would have been desirable in connection with the online document of *Mitchell et al*, or why a person having ordinary skill in the art would have perceived any such desirability from the references.

The Office Action further cites a passage of *Mitchell et al* for the propositions that the software is written to run within a World Wide Web browser and that the distribution file of the World Wide Web browser is written on the medium. That passage of *Mitchell et al* says that a World Wide Web browser is used, but does not identify any viewing software that is written to run within such a browser and does not even remotely suggest writing the distribution file on the medium.

With regard to claims 68-84, the Office Action cites various portions of *Mitchell et al* for teaching of a reverse side viewable file, highlighting, and viewing additional information such as a bill. However, the passages of *Mitchell et al* cited in the Office Action

do not teach highlighting information representing a position of the selected item on the page, but instead only teach highlighting page numbers as they appear in text form in a search result. There is passing mention of showing words or phrases having links in reverse video, but there is no teaching of exactly how that is done; thus, there is no enabling teaching for the highlighting information, the viewable file and the software to highlight the position, as claimed. With regard to the reverse side viewable file and the bill, those features are entirely absent from *Mitchell et al.* With regard to the additional information which is not included in the document, the Office Action points to links shown in the drawings; however, those links operate within the document and do not go to additional information which is not included in the document.

Claims 1-9, 12, 40-50 and 53-67 are rejected under 35 U.S.C. §103(a) over *Mitchell et al* in view of *Barrett et al.* On that ground of rejection, the Applicants respectfully submit the following comments in addition to those set forth above. The invention as defined in those claims includes steps of providing a print queue and converting the print queue into a plurality of viewable files without an intermediary step of producing hard copies of the pages. The Office Action acknowledges that *Mitchell et al* does not teach providing a print queue or converting the print queue into the viewable files. As for the lack of an intermediary step of producing hard copies, *Mitchell et al* does not teach that limitation either, since that reference starts with hard copies. Instead, the Office Action cites *Barrett et al* for teaching of a print queue and argues that it would have been obvious to combine the print queue of *Barrett et al* into the technique of *Mitchell et al* "because it would allow hard

copies of the electronic document to be printed.” However, the whole point of the technique of *Mitchell et al* is that it starts with hard copies and converts them into an electronic document, with the consequence that the reference teaches away from the present claimed invention. The Office Action does not explain why any additional ability to print hard copies would have been desirable or, even if it were, how the print queue of *Barrett et al* would have been integrated into *Mitchell et al* to achieve such a purpose.

With regard to claim 3, the Office Action argues that in *Mitchell et al*, the data to be rasterized inherently comprise PostScript data. The Applicants respectfully submit that such is not the case. In *Mitchell et al*, the data to be rasterized are hard copies of the document to be imaged; such data do not and cannot inherently comprise PostScript data.

With regard to claim 42, the passage in *Mitchell et al* cited for selectively viewing the file either with or without the selected item highlighted actually teaches no such thing. All it teaches is that page numbers in the search result are highlighted.

As will be seen from the above, none of the combinations of references applied in the outstanding Office Action would have motivated a person having ordinary skill in the art to realize the present claimed invention. Therefore, the Applicants respectfully submit that the present claimed invention is patentable and request that the outstanding grounds of rejection be withdrawn.

As all grounds of objection and rejection have been addressed and overcome, entry of this Amendment and issuance of a Notice of Allowance of claims 1-84 are respectfully solicited.

In the event that there are any questions relating to this Amendment or to the application in general, it would be appreciated if the Examiner would telephone the undersigned attorney concerning such questions so that the prosecution of this application may be expedited.

Please charge any shortage of fees or credit any overpayment thereof to BLANK ROME COMISKY & McCAULEY LLP, Deposit Account No. 23-2185 (107227.00102).

In the event that a petition for an extension of time does not accompany this response or is insufficient to render this submission timely, the Applicants herewith petition under 37 C.F.R. §1.136(a) for an extension of time for as many months as are required to render this submission timely. Any fee due is authorized above.

Respectfully submitted,

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